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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,611	12/21/2000	Thad R. Perry	10022/24	2184
28164	7590	10/20/2005	EXAMINER	
ACCENTURE CHICAGO 28164 BRINKS HOFER GILSON & LIONE P O BOX 10395 CHICAGO, IL 60610			COLON, CATHERINE M	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/746,611

Applicant(s)

PERRY ET AL.

Examiner

C. Michelle Colon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4,7,8,12-18,22-26 and 28-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7,8,12-18,22-26 and 28-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The following is a Final Office Action in response to the communication received on August 3, 2005. Claims 1, 18 and 32 have been amended. Claims 2, 5, 6, 9-11, 19-21 and 27 have previously been cancelled. Claims 1, 3, 4, 7, 8, 12-18, 22-26 and 28-48 are now pending in this application.

#### ***Response to Amendment***

2. Applicant's amendments to claims 1, 18 and 32 are acknowledged. It is noted that claim 6 and its status are missing from the claims listing. The claim and its status must be added to the claims listing in the next response in order to avoid a potential non-responsive amendment notice.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 4, 7, 8, 12-18, 22-26, 28-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article, "Public Private Partnership," May 1999 and the proposal evaluation tool, FedSelect, September 1999.

As per claim 1, "Public Private Partnership" discloses a method of evaluating a business proposal, comprising the steps of:

gathering information relevant to the proposal, wherein the information comprises revenue elements of the proposal, risks, descriptive information, business issues, business goals, a value of the proposal, a cost of the proposal, methods of achievement of the proposal, and an innovation value of the proposal, and wherein the proposal includes at least one alternative structure between a purchaser and a provider selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture (last paragraph of page 6; Figure 2.1 beginning on page 7, Types of Public Private Partnerships; pages 67-72; The article discloses the different ways to structure partnership deals/proposals, which include different levels of risk, rewards and responsibilities to the parties involved. The article also discusses the requirements of the contents of a proposal including cost, business issues, methods of achievement, as well as management and business plans that detail the proposed business and legal structures between the parties.);

evaluating the gathered information (pages 74 and 75; The article discloses evaluating the information relevant to the proposals using various evaluation criteria.); and

ranking the structures by cost, a rate of return, an assessment of potential future benefits, and a revenue stream (pages 72, 74-77 and 80; Proposal evaluators rank each evaluation criterion for each proposal and then adding the scores to determine the best-suited proposal. The evaluation criteria is a checklist of the proposal requirements listed on pages 69-72. The proposal evaluation criteria (and proposal requirements) include the allocation of risks and rewards between government and the private entities

such as life-cycle costs (i.e., costs), value for money (i.e., revenue and return on investment), and likelihood that potential partner can achieve proposed solution (i.e., assessment of potential future benefits). Additionally, the "value engineering component" requirement of the proposal (page 72) is evaluated on innovation, benefits and cost savings.).

"Public Private Partnership" does not expressly disclose a proposal containing at least two alternative structures between a purchaser and a provider selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture. However, "Public Private Partnership" does disclose that public private partnerships are arrangements between government and private sector entities that can take various forms that result in different allocations of risk, responsibility and reward depending on the business arrangement established (pages 3 and 5). "Public Private Partnership" further discloses that public private partnership arrangements range from leases, contracts of services and infrastructure financing to government partnerships involving jointly controlled operations, assets or organizations (last paragraph of page 41). Thus, "Public Private Partnership" teaches that different structures may be formed between government and private entities, including alliances, acquisitions, partnerships, and ventures. Likewise, "Public Private Partnership" discloses that structures such as partnerships and alliances may be formed between private entities before a proposal to government is submitted, which reduces the number of potential proposal submissions for government to evaluate (middle of page 55). Additionally, "Public Private Partnership" discloses that contract negotiations occur between government and private

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entities in order to find the best deal, or business arrangement, for both parties (last paragraph of page 47; page 78). "Public Private Partnership" discloses carefully wording a request for proposal (RFP) to appear flexible and open to negotiations with regards to the business arrangements, or structures, established between government and private entities (first paragraph of page 54). Accordingly, at the time of the invention, it would have been obvious to a person of ordinary skill in the art for the RFP and proposal evaluation process taught by "Public Private Partnership" to allow for private entities to submit proposals that include at least two alternative structures from the group consisting of alliances, acquisitions, partnerships, and ventures since "Public Private Partnership" already teaches such structures being commonly established between government and private entities for the delivery of services and infrastructure (top of page 3), and that it is also common for private entities to form structures among themselves prior to submitting a proposal to government (middle of page 55). Thus, submitting a proposal with at least two structures would further support government's desire of reducing the potential number of proposals received for evaluation and thus, help expedite the proposal evaluation process as taught by "Public Private Partnership."

"Public Private Partnership" also does not expressly disclose evaluating the information by computer. FedSelect discloses a software tool that allows users to evaluate proposals using a computer (page 3). It was known at the time of the invention that merely providing an automated way to replace a well-known activity which accomplishes the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). Thus, at the time of the

invention it would have been obvious to a person of ordinary skill in the art for the proposal evaluation process of "Public Private Partnership" to utilize a computer as taught in the proposal evaluation software tool of FedSelect because automating many of the manual evaluation steps would streamline the proposal evaluation process, thus making it more efficient (page 4 of FedSelect disclose a benefit of the tool as streamlining the proposal evaluation process).

As per claim 3, "Public Private Partnership" discloses the method of claim 1, wherein the information gathering step comprises answering predetermined questions (pages 69-72; In the form of proposal requirements, private entities must answer predetermined questions in their proposals in order for their proposals to be considered and evaluated.). "Public Private Partnership" does not expressly disclose wherein the predetermined questions are on at least one template stored in a computer and the answers to at least one predetermined question call up at least one more template of predetermined questions. However, computer-driven templates merely automate the information gathering step already taught by "Public Private Partnership." As discussed above, it was known at the time of the invention that merely providing an automated way to replace a well-known activity which accomplishes the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). Thus, at the time of the invention it would have been obvious to a person of ordinary skill in the art for the proposal evaluation process of "Public Private Partnership" to gather information utilizing templates on a computer because the templates would help to automate and streamline the information gathering process,

thus making the proposal submission and evaluation process more efficient, which is a desire taught by "Public Private Partnership" (page 55).

As per claim 4, "Public Private Partnership" discloses the method of claim 1, wherein the proposals are evaluated by calculating at least one of a revenue stream, a return on average assets, a return on investment, a return on equity, an internal rate of return, and a net present value (pages 69-72; The evaluation criteria is a checklist of the proposal requirements listed on pages 69-72. Part of the proposal requirements, and therefore evaluation criteria, includes the submission of a financial plan that includes acceptable and expected rates of return as well as sources of revenue.).

As per claims 7, 12, 13 and 15-17, "Public Private Partnership" does not expressly disclose the method of claim 1, further comprising displaying the rankings with a graphical user interface; or wherein the information is input to the computer through a graphical user interface by choosing selections from at least one of a drop-down screen, a scroll screen, a check box, and a list box; or wherein the information is provided through a graphical user interface, and the input is in a form of brief numerical or pseudo-numerical outputs. FedSelect discloses displaying the rankings and having evaluators submit information via a graphical user interface (page 3). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teachings of "Public Private Partnership" and FedSelect based on the rational and motivation supplied in the claims above.

As per claim 8, "Public Private Partnership" and FedSelect do not expressly disclose the method of claim 7, wherein the rankings are presented in a Harvey-ball



format. However, FedSelect discloses displaying rankings via a graphical user interface (page 3). The Harvey-ball format is an old and well known display format that uses moon phases to indicate association levels of an item based on certain criteria. The Harvey-ball format provides a quick and easy way for a user to view compare items based on certain criteria. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to display rankings of items using a Harvey-ball format because such a display would provide users with a quick and easy means for assessing the rankings.

As per claim 14, "Public Private Partnership" discloses the method of claim 1, wherein the proposal comprises an offer of a service from the provider, and further comprising the step of calculating a way to pay for the proposal (page 2; Figure 2.1 beginning on page 7; page 71; The article discloses establishing partnerships to deliver some type of service. The financial plan, a requirement of the proposal, includes sources of funding.).

Claims 18, 22-26 and 28-38 recite substantially similar subject matter as claims 1, 3, 4, 7, 8 and 12-17 above. Therefore, claims 18, 22-26 and 28-38 are rejected on the same basis as claims 1, 3, 4, 7, 8 and 12-17.

As per claim 39, "Public Private Partnership" discloses the method of Claim 1, wherein the alternative structures between the purchaser and the provider differ in an amount of equity owned by the purchaser and the provider (pages 42, 71, 98; Figure 2.1

beginning on page 7; The article discloses that different amounts of equity may be owned by the parties involved in the partnership structure based on the type of structure established.).

As per claim 40, "Public Private Partnership" discloses the method of Claim 1, wherein an advantage of at least one of the structures is creation of an asset (pages 68, 94 and 97; The article discloses the transfer of assets that may arise from a particular deal structure.).

As per claim 41, "Public Private Partnership" discloses the method of Claim 1, wherein the provider furnishes information to the purchaser demonstrating a difference in value to the purchaser based on the alternative structures (pages 45, 54, 71 and 72; The article discloses how all parties in the potential partnership assess the various partnership structure types for their value.).

As per claim 42, "Public Private Partnership" discloses the method of Claim 1 wherein at least one of cost drivers and revenue drivers is used to evaluate and rank the structures (pages 71 and 80; The article discloses considerations of revenue, cost, ROI, etc. when evaluating the proposals.).

As per claim 43, "Public Private Partnership" discloses the method of Claim 1, wherein the values of the at least two alternative structures are calculated as revenue streams to the purchaser (pages 44 and 71; The article discloses a party considering the revenue generating potential of establishing the partnership.).

As per claim 44, "Public Private Partnership" discloses the method of Claim 1, wherein the values of the at least two structures are calculated as at least one of a

revenue stream, a return on average assets, a return on investment, a return on equity, an internal rate of return, and a net present value (pages 44 and 71; Figure 2.1 beginning on page 7; The article discloses assessing revenue stream, ROI, etc. for the different types of partnership structures.).

As per claim 45, "Public Private Partnership" discloses the method of Claim 18, wherein the provider is a service provider and the advantages of the structures are calculated as a revenue stream to the purchaser (pages 44 and 71; The article discloses a party considering the revenue generating potential of establishing the partnership.).

As per claim 46, "Public Private Partnership" discloses the method of Claim 18, wherein the alternative structures differ in an amount of equity owned by the purchaser and the provider (pages 42, 71 and 98; Figure 2.1 beginning on page 7; The article discloses that different amounts of equity may be owned by the parties involved in the partnership structure based on the type of structure established.).

As per claim 47, "Public Private Partnership" discloses the method of Claim 18, wherein an advantage of at least one of the structures is creation of an asset (pages 68, 94 and 97; The article discloses the transfer of assets that may arise from a particular deal structure.).

As per claim 48, "Public Private Partnership" discloses the method of Claim 18, wherein at least one of cost drivers and revenue drivers is used to calculate advantages for the structures (pages 71 and 80; The article discloses considerations of revenue, cost, ROI, etc. when evaluating the proposals.).

***Response to Arguments***

5. Applicant's arguments with regard to the newly amended claims are moot in view of the new and/or updated grounds of rejections provided above.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Colon whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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or faxed to:

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emc

October 14, 2005



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